REMARKS

In response to the Office Action mailed June 19, 2006, Applicants respectfully request reconsideration. To further the prosecution of this application, each of the rejections set forth in the Office Action has been considered and is addressed below. The claims as presented are believed to be in condition for allowance.

Claims 17-50, 59-74 and 83-118 were previously pending in this application. No claims have been amended, added or canceled. As a result, claims 17-50, 59-74 and 83-118 remain pending, with claims 17, 34, 59, 83, 100, 107, 109 and 114 being independent. No new matter has been added.

Rejections Under 35 U.S.C. §103

Claims 17-50, 59-74 and 83-118 stand rejected under 35 U.S.C. §103(a) as purportedly being obvious in view of U.S. Patent No. 6,128,602 to Northington et al. ("Northington") in view of U.S. Patent No. 5,739,512 to Tognazzini ("Tognazzini"). Applicants respectfully traverse this rejection, as the Office Action fails to set forth a *prima facie* case of obviousness, and the claims patentably distinguish over any combination of the asserted references.

I. The Office Action Fails To Set Forth A *Prima Facie* Case Of Obviousness

The Office Action fails to set forth a *prima facie* case of obviousness, as one skilled in the art would not have been motivated to combine the references in the manner asserted, and the Office Action fails to explain the system one skilled in the art would purportedly have been led to based on the combined teachings of the references.

A. One Skilled In The Art Would Not Have Been Motivated To Combine The References In The Manner Asserted

The Office Action fails to set forth a *prima facie* case of obviousness because no properly supported motivation is established for combining the references in the manner asserted.

As a preliminary matter, Applicants respectfully point out that the Office Action fails to properly explain how it is believed the references meet the claim limitations, as required by M.P.E.P. §706.02(j) and 37 C.F.R. §1.104(c)(2). For example, with regard to independent claim 17, the Office Action fails to explain whether Northington or Tognazzini is relied upon to meet the limitation of determining, as a function of each unique identifier, whether an associated client has consented to receiving respective financial data electronically. The Office Action appears to ignore the remainder of the claims altogether, such that Applicants are forced to speculate as to how the claim limitations are believed to be met by the prior art of record. For at least this reason, the rejection is improper.

Applicants believe, based on the brief explanation provided, that the Office Action contends (with respect to claim 17) that Northington is relied upon to meet all of the claim limitations except for determining, as a function of each unique identifier, whether an associated client has consented to receiving respective financial data electronically (although Applicants note that the Office Action asserts that Northington "suggests" this limitation). The Office Action appears to contend that Tognazzini discloses this limitation, although it does not explicitly say so. The Office Action contends that one skilled in the art would have been motivated to modify the system of Northington according to the teachings of Tognazzini "to allow the delivery of financial information electronically at a user's consent with the motivation of providing users with an authentic receipt of their financial transactions." These contentions are unsupported by the references.

One skilled in the art would not have been motivated to modify the system of Northington according to the teachings of Tognazzini. Northington discloses a system wherein information from a plurality of financial systems is consolidated (col. 2, lines 29-32). The system enables a user to monitor and manage financial activities (e.g., spending and purchase activity) with multiple independent entities (col. 2, lines 33-41). Northington discloses that users may access electronic financial data via a remote terminal, run reports, monitor spending, etc. (col. 5, lines 40-56). As such, the system disclosed by Northington provides a centralized facility which a user can employ to manage multiple accounts and view activity on those accounts via a remote terminal.

By contrast, Tognazzini discloses a system wherein financial data is transmitted to a user. Specifically, Tognazzini discloses a technique whereby electronic receipts are transmitted to a customer in place of paper receipts (col. 2, lines 17-20). For example, a customer making a credit card purchase may be emailed a receipt for the transaction (col. 2, lines 32-37). Tognazzini discloses that Electronic Data Interchange (EDI) techniques can be employed to facilitate this data transfer (col. 6, lines 26-39). In describing the features of EDI generally, Tognazzini states, in a passage quoted by the Office Action, that EDI can allow businesses to send and receive electronic messages without human intervention. For example, businesses which have previously agreed to the format of specific EDI messages may exchange information automatically without expensive backroom procedures (col. 5, lines 55-59).

For several reasons, one skilled in the art would not have been motivated by Tognazzini to modify the system of Northington. First, because the system of Northington allows the user to view the details of previous transactions (i.e., information that would be provided in a receipt), the technique of sending an electronic receipt taught by Tognazzini would be superfluous in the system of Northington. In addition, the system of Northington does not allow a user to perform a transaction, but rather to monitor previous transactions. Because no transaction is performed in the system of Northington, there is no need for the electronic receipt taught by Tognazzini.

Further, the arrangement described in the passage of Tognazzini that is quoted by the Office Action is incompatible with the system of Northington. Again, the quoted passage describes an automatic transfer of information between businesses which have previously agreed on specific EDI messages and formats. Northington, however, says nothing about a transfer of information between businesses. In the system of Northington, data describing a user's dealings with multiple businesses is consolidated. The two arrangements are simply incompatible.

In view of the foregoing, one skilled in the art would not have been motivated by Tognazzini modify the system disclosed by Northington, and certainly not in the manner alleged.

B. No Explanation Is Provided Of The System That One Skilled In The Art Would Purportedly Have Been Led To Based On The Combined Teachings Of The References

To establish a *prima facie* case of obviousness, the Office Action must explain the type of system one skilled in the art would purportedly have been led to based on the combined teachings of the cited references. M.P.E.P. §2142. That is, the Examiner must explain "the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter." M.P.E.P. §706.02(j). Hindsight knowledge of the Applicants' disclosure may not be employed to simply pick and choose features from various references. M.P.E.P. §2142. The Office Action fails to meet this burden, as it simply uses the claims as a template to pick and choose various features of the prior art, and provides no explanation of the type of system that would purportedly have resulted from combining the disclosures of Northington and Tognazzini. This is improper.

Moreover, Applicants are unclear as to exactly what type of system could have resulted from following the combined teachings of the references. Again, Northington discloses a system which provides a user with a consolidated view of financial transactions with multiple entities, while Tognazzini discloses a system which replaces paper receipts with electronic ones. The electronic receipts disclosed by Tognazzini would be superfluous in the system of Northington, which allows a user to view information that would typically be displayed on a receipt.

In view of the foregoing, the Office Action fails to set forth a *prima facie* case of obviousness, such that the rejection of claims 17-50, 59-74 and 83-118 under 35 U.S.C. §103(a) should be withdrawn.

II. The Claims Patentably Distinguish Over Any Combination Of The Asserted References

A. Claims 17-33

Claim 17 recites a method of making financial transaction information available electronically. The method comprises: (a) receiving financial transaction data for a plurality of distinct financial transactions; (b) determining a unique identifier for each distinct financial transaction and a client associated with each distinct financial transaction; (c) determining, as a

function of each unique identifier, whether the associated client has consented to receiving the respective financial data electronically; and (d) if it is determined that the associated client has consented to receiving the respective financial data electronically, making the respective financial transaction data available to the associated client electronically.

The asserted references fail to disclose or suggest the totality of limitations recited by claim 17. For example, neither Northington nor Tognazzini discloses or suggests determining, as a function of each unique identifier, whether an associated client has consented to receiving respective financial data electronically.

As discussed above, the Office Action appears to contend that Tognazzini discloses this limitation, and also states that Northington "suggests" it. These contentions are unsupported by the references.

Tognazzini discloses a technique for replacing paper receipts with electronic ones, and for transmitting these receipts via EDI techniques (col. 6, lines 26-39). In the passage quoted by the Office Action, Tognazzini discloses, in describing EDI capabilities generally, that businesses which agree in advance on the EDI message structures to be employed, and the meaning of each data elements in the message structures, may exchange information electronically without human intervention (col. 5, lines 55-59). For example, Company A may send a purchase order to Company B, and Company B may automatically send an acknowledgment of the order back to Company A (col. 5, lines 59-64).

Tognazzini does not disclose or suggest determining whether consent exists for receiving financial data electronically, as required by claim 17. In the example given in the quoted passage, two businesses have previously agreed to an electronic exchange of information and the format in which the information will be provided. Because the businesses previously agreed to the exchange, there would be no need to make a determination whether consent exists for providing financial data electronically, as required by claim 17.

Moreover, Tognazzini also fails to disclose or suggest determining whether a client has consented to receiving financial data electronically *as a function of a unique identifier assigned to each of a plurality of financial transactions*, as required by claim 17. Tognazzini simply says

nothing at all about making a determination as a function of any unique identifier, and certainly not a unique identifier assigned to each of a plurality of financial transactions.

Northington also fails to disclose or suggest this limitation. Northington discloses a system which provides a user with a consolidated view of financial transactions with a plurality of entities and allows the user to run reports relating to those transactions. The Office Action contends that these capabilities "suggest" that the user provides consent to receive financial data electronically. As such, the Office Action appears to take the position that even if Northington does not explicitly disclose determining whether consent exists, this capability is inherent in the disclosure of Northington. M.P.E.P. §2112(IV) provides that inherency is an exceedingly difficult standard to meet (emphasis added):

> To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is ***necessarily*** present in the thing described in the reference and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.

As a result, unless the system of Northington must be able to perform a determination whether consent exists for receiving financial data electronically, it does not inherently do so. Because Northington does not explicitly state that this type of determination is performed, the rejection under 35 U.S.C. §103(a) is improper.

In addition, Northington, like Tognazzini, says nothing at all about making a determination as a function of a unique identifier assigned to each of a plurality of financial transactions.

For each of the foregoing reasons, claim 17 patentably distinguishes over the prior art of record, such that the rejection of claim 17 under 35 U.S.C. § 103(a) as purportedly being obvious in view of a combination of Northington and Tognazzini should be withdrawn.

Claims 18-33 depend from claim 17 and are allowable for at least the same reasons.

B. Claims 34-50

Claim 34 recites a system for making financial transaction information available electronically. The system comprises (a) means for receiving financial transaction data for a plurality of distinct financial transactions; (b) first means for determining a unique identifier for each distinct financial transaction and a client associated with each distinct financial transaction; (c) second means for determining, as a function of each unique identifier, whether the associated client has consented to receiving the respective financial data electronically; and (d) means for making the respective financial transaction data available to the associated client electronically if it is determined that the associated client has consented to receiving the respective financial data.

It should be clear from the discussion above related to claim 17 that claim 34 fails to disclose or suggest means for determining, as a function of each unique identifier, whether an associated client has consented to receiving respective financial data electronically. Accordingly, claim 34 patentably distinguishes over the asserted combination, such that the rejection of claim 34 under 35 U.S.C. §103(a) as purportedly being obvious in view of the combination of Northington and Tognazzini should be withdrawn.

Claims 35-50 depend from claim 34 and are allowable for at least the same reasons.

C. Claims 59-74

Claim 59 recites a computer program product comprising a computer-readable medium; and computer program instructions, wherein the computer program instructions, when executed by a computer, direct the computer to perform the method of making financial transaction information available via a communications channel, the method comprising: (a) receiving financial transaction data for a plurality of distinct financial transactions; (b) determining a unique identifier for each distinct financial transaction and a client associated with each distinct financial transaction; (c) determining, as a function of each unique identifier, whether the associated client has consented to receiving the respective financial data via the communications channel; and (d) if it is determined that the associated client has consented to receiving the

respective financial data, making the respective financial transaction data available to the associated client via the communications channel.

It should be clear from the discussion above regarding claim 17 that the asserted combination fails to disclose or suggest computer program instructions which, when executed, perform a method which includes determining, as a function of each unique identifier, whether an associated client has consented to receiving respective financial data via a communications channel. Accordingly, claim 59 patentably distinguishes over the asserted combination, such that the rejection of claim 59 under 35 U.S.C. §103(a) as purportedly being obvious in view of the combination of Northington and Tognazzini should be withdrawn.

Claims 60-74 depend from claim 59 and are allowable for at least the same reasons.

D. Claims 83-99

Claim 83 recites a system for making financial transaction information available via the Internet. The system comprises: (a) a financial transaction data processor to receive financial transaction data for a plurality of distinct financial transactions; (b) an identifier processor, coupled to the financial transaction data processor, to determine a unique identifier for each distinct financial transaction and a client associated with each distinct financial transaction; (c) a consent processor, coupled to the identifier processor, to determine, as a function of each unique identifier, whether the associated client has consented to receiving the respective financial data electronically; and (d) a processor, coupled to the consent processor, to make the respective financial transaction data available to the associated client electronically if it is determined that the associated client has consented to receiving the respective financial data.

It should be clear from the discussion above related to claim 17 that the asserted combination fails to disclose or suggest a consent processor to determine, as a function of each unique identifier, whether an associated client has consented to receiving the respective financial data financially. Accordingly, claim 83 patentably distinguishes over the asserted combination, such that the rejection of claim 83 under 35 U.S.C. §103(a) as purportedly being obvious in view of the combination of Northington and Tognazzini should be withdrawn.

Claims 84-99 depend from claim 83 and are allowable for at least the same reasons.

E. Claims 100-106

Claim 100 recites a method of providing financial data electronically to a user. The method comprises obtaining consent from the user to provide the data electronically; and providing the financial transaction data electronically to the user.

As discussed above with regard to claim 17, neither Northington nor Tognazzini disclose or suggest obtaining consent from a user to provide financial data electronically. As a result, claim 100 patentably distinguishes over the asserted combination of Northington and Tognazzini, such that the rejection of claim 100 under 35 U.S.C. §103(a) as purportedly being obvious in view of a combination of Northington and Tognazzini should be withdrawn.

Claims 101-106 depend from claim 100 and are allowable for at least the same reasons.

F. Claims 107-108

Claim 107 recites a method of obtaining and storing consent, from a user, to receive financial transaction data electronically. The method comprises, under control of a client system: sending a consent message with respect to the financial transaction data; under control of a first server system: receiving the consent message from the client system; correlating the consent message to account information of the user and generating consented account information data; sending the consented account information data; under control of a second server system: receiving the consented account information data from the first server; determining a unique user identifier from the consented account information; and storing the consented account information as a function of the unique user identifier.

As discussed above in relation to claim 17, neither Northington nor Tognazzini discloses or suggests obtaining or storing consent from a user to receive financial transaction data electronically. Accordingly, claim 107 patentably distinguishes over the asserted combination,

such that the rejection of claim 107 under 35 U.S.C. §103(a) as purportedly being obvious in view of the combination of Northington and Tognazzini should be withdrawn.

Claim108 depends from claim 107 and is allowable for at least the same reasons.

G. Claims 109-113

Claim 109 recites a method of providing financial transaction data electronically. The method comprises: under control of a first server system: (A) receiving a request to receive financial transaction data from a client system; (B) validating the request; and (C) when the request is determined to be valid, providing the financial transaction data to the client system.

The Office Action fails to explain how the limitations of claim 109 are believed to be met by the prior art of record. Regardless, neither of the asserted references discloses or suggests the totality of limitations recited by claim 109. For example, neither Northington nor Tognazzini disclose validating a request to retrieve financial transaction data from a client system. Accordingly, claim 109 patentably distinguishes over the asserted combination, such that the rejection of claim 109 under 35 U.S.C. §103(a) as purportedly being obvious in view of the combination of Northington and Tognazzini should be withdrawn.

Claims 110-113 depend from claim 109 and are allowable for at least the same reasons.

H. Claims 114-118

Claim 114 recites a method of sending financial transaction data electronically to a user. The method comprises: under control of a first server system: receiving financial transaction data; identifying a user associated with the received financial transaction data; storing the received financial transaction data as a function of the identified user; determining if the identified user has consented to receiving the financial transaction data electronically; and when it has been determined that the user has consented, sending the received financial transaction data electronically to the user.

It should be clear from the discussion above regarding claim 17 that the asserted combination fails to disclose or suggest determining if a user has consented to receiving financial transaction data electronically. Accordingly, claim 114 patentably distinguishes over the asserted combination, such that the rejection of claim 114 under 35 U.S.C. §103(a) as purportedly being obvious in view of the combination of Northington and Tognazzini should be withdrawn.

Claims 115-118 depend from claim 114 and are allowable for at least the same reasons.

CONCLUSION

A Notice of Allowance is respectfully requested. The Examiner is requested to call the undersigned at the telephone number listed below if this communication does not place the application in condition for allowance.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicants hereby request any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 23/2825.

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Respectfully submitted,

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